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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,251	08/03/2001	Yoshio Harada	P21030	6273

7055 7590 03/17/2003

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EXAMINER

SAVAGE, JASON L

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 03/17/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/890,251

Applicant(s)

HARADA ET AL.

Examiner

Jason L. Savage

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-12, 14 and 16-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 3, 7, 9-12, 14, 16-20, 25-32 and 37-44 is/are allowed.
- 6) ☒ Claim(s) 1, 8, 21-24 and 33-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claim 1, 8, 21-24 and 33-36 are rejected under 35 U.S.C. 102(a) as being anticipated by JP'484 (JP 2001-031484).

JP'484 teaches a member that is exposed to plasma and halogen-based corrosive gasses which has a coating formed from a rare earth oxide such as Y_2O_3 (abs.). This coating is formed by thermal spraying (abs.).

Regarding claims 21-24 and 33-36, JP'484 teaches that the coating may contain 100% Y_2O_3 which meets the claim limitations (Example 1 listed in the table between columns 3 and 4).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1, 8, 23 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP'467 (JP 10-045,467).

JP'467 teaches a substrate for a plasma treating vessel having a coating thereon which comprises Y_2O_3 and Al_2O_3 (abs.). JP'467 is silent to the method used to form the Y_2O_3 containing coating; however claim 1 is drawn to the article, not the method of making. Absent a teaching of the criticality of the claimed method, it does not provide a patentable distinction over the prior art. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used any suitable method for forming the coating taught by JP'467. When there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that same process of making, see *In re Brown*, 173 U.S.P.Q. 685, and *In re Fessmann*, 180 U.S.P.Q. 324.

Regarding claim 8, JP'467 is silent to the method used, however it does teach that the coating is a sintered compact (abs.). Absent a teaching of the criticality of forming the coating by spraying, it does not provide a patentable distinction over the prior art. Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used any known method for forming a multiple oxide containing coating, including thermally spraying, in order to have formed a coating which was a sintered compact of oxide materials.

Regarding claims 23 and 35, the coating of JP'467 consists essentially of Y_2O_3 and meets the claim limitations.

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Allowable Subject Matter

5. Claims 2-3, 7, 9-12, 14, 16-20, 25-32 and 37-44 are allowed.
6. The following is a statement of reasons for the indication of allowable subject matter: The prior art teaches coatings for plasma treating vessels wherein the coating comprises a surface layer of Y_2O_3 such as is claimed by Applicant. However, the prior art does not teach a coating containing a Y_2O_3 surface layer which further contains an metal film undercoat or an undercoat with a middle layer formed between the undercoat and the Y_2O_3 surface layer.

Response to Arguments

7. Applicant's arguments filed 1-6-03 have been fully considered but they are not persuasive.

Applicant argues that JP'467 does not teach or suggest an internal member or it's manner of production. First, 'internal member' is a statement of intended use. Statements of intended use are not considered patentably distinguishing limitations. See Ex parte Masham 2 U.S.P.Q.2d 1647, 1648. In re Thuau 135 F.2d 344, 47 U.S.P.Q. 324. Application of Hack, 245 F.2d.246, 114 U.S.P.Q. 161. Second, the coated member of JP'467 would be just as capable of being used as an internal member of a plasma treating vessel since JP'467 cites the coated member as having advantageous corrosion resistance to halogen containing plasma (abs). Therefore, Applicant's assertion that JP'467 does not teach what is claim is not persuasive.

Applicant further argues that the rejection failed to set forth the deficiency in the reference and how the reference was being modified to overcome the deficiency and thus states

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that the rejection does not have appropriate basis. The deficiency and method of modification has been clearly set forth in the present rejection.

Applicant also argues that JP'467 teaches that the corrosion-resistant member is composed of a composite oxide and further cites several composite oxides used in the reference. Almost all of the cited composite oxides include Y_2O_3 and therefore would meet the limitation of being a Y_2O_3 coating. Should Applicant be arguing that the content of the Y_2O_3 in the coating of JP'467 is not as high as that of the present invention, the claims rejected over JP'467 do not recite any particular Y_2O_3 content. Thus, any argument based on the Y_2O_3 content in the coating of JP'467 is not commensurate in scope with the claims rejected over this reference.


8. Any inquiry to this communication or earlier communications from the Examiner should be directed to Jason Savage, whose telephone number is (703)305-0549. The Examiner can normally be reached Monday to Friday from 6:30 AM to 4:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Deborah Jones, can be reached on (703)308-3822.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-2351.


Jason Savage

3-10-03


JOHN J. ZIMMERMAN
PRIMARY EXAMINER